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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 976

JOHNSON & JOHNSON,

Petitioner,

vs.

THE KENDALL COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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This is an ordinary suit for alleged patent infringement in which the Court of Appeals for the Seventh Circuit correctly held plaintiff-petitioner's Gross patent No. 2,703,083, relating to an "adhesive bandage" to be invalid for lack of patentable invention. The opinion of the Court of Appeals is reported at 327 F. 2d 391. The District Court for the Northern District of Illinois had held the patent valid and infringed in an opinion reported at 215 F. Supp. 124.*

The Court of Appeals holding that the patent in suit is invalid for lack of invention does not present any unsettled or disputed question of law. There is no conflict with decisions of this Court or of any Court of Appeals. The case presents no question of general interest or public importance. There is no reason why this Court should grant certiorari.

Furthermore, not only is the decision that the patent is invalid entirely correct, but dismissal of the complaint

*Our references to the Court of Appeals opinion will be to the opinion as printed in Appendix A to the Petition, pp. i-xi. All emphasis in quoted matter has been supplied.

would be required in any event because of lack of infringement and functional claiming,—defenses that the Court of Appeals found it unnecessary to pass on in view of its decision of lack of invention.

Brief Statement of Facts

The relevant and determinative facts of the case, which are essentially undisputed, being based on documentary evidence and undisputed oral testimony, are correctly set forth in the Court of Appeals' opinion. The so-called "findings of fact" in the District Court, heavily relied on in plaintiff's petition, were submitted by plaintiff ar adopted verbatim by the District Court and are largely argumentative and conclusory. In so far as they differ from the facts set forth by the Court of Appeals, these findings were necessarily rejected as clearly erroneous.

Adhesive bandages, with which the patent is concerned, have been familiar household articles for thirty years or more. Plaintiff-petitioner's product is marketed under its trade-mark "BAND-AID"; defendant's under its trade-mark "CURAD".

Such bandages consist of a short strip of adhesive tape to the center of which a small gauze pad is affixed. The gauze pad and the adhesive surface are protected prior to use by facing strips intended to be removed by the user immediately prior to applying the bandage to a wound. Each bandage is packed by the manufacturer in an individual envelope in which it is sealed and sterilized. As originally marketed, the removable facing strips were of crinoline, a starched gauze. As currently supplied, the facing strips on the products of both parties are of smooth surfaced plastic film. The patent is concerned with the substitution of smooth plastic film for the crinoline originally used for the protective facings.

The crinoline which was originally used had many virtues—being inexpensive, easily steam-sterilizable, inert to the adhesive and readily removable from it. It did have the minor disadvantage that because of its rough texture, when pressed into close contact with the adhesive surface, that surface was roughened, the roughness persisting upon removal of the facing. When this slightly roughened adhesive surface was brought into contact with a smooth surface to which it was to be applied, only the high spots of the adhesive would be involved in the initial contact, a perceptible interval of time and the application of some slight smoothing pressure being required to bring the non-protruding portions of the adhesive surface into effective contact with the user's skin. When the smooth-surfaced plastic facing strips currently used by both parties are removed, the adhesive surface which is thereby exposed is much smoother than the formerly conventional crinoline-roughened surface. When a bandage having such a smooth adhesive surface is brought into contact with the skin, every portion of the adhesive surface immediately participates in the contact and contributes to the overall adhesiveness. Thus a bandage using smooth facing strips has greater adhesiveness upon initial contact—greater "quick-stick", in the language of the case—than a bandage using the previously conventional crinoline facings.

Plaintiff's contention, successful in the District Court, was that prior to its invention, it was commonly supposed that a roughened adhesive surface would stick better to the skin than a smooth surface and therefore that plaintiff's patentee had done something unobvious in suggesting the use of a facing made of smooth material. The District Court adopted and acted on the argument presented to it by plaintiff that if it had been obvious to use smooth facing strips surely someone would have earlier applied such facings to their commercial product.

As the Court of Appeals understood and held, what actually happened was that, whatever the untutored person may have thought about the merits of a roughened adhesive surface, the knowledgeable employees of both parties were well aware long prior to the supposed invention of this patent, that greater adhesiveness upon initial contact could be and was achieved when the adhesive surface was smoothed by contact with a facing of smooth material, and this principle had been purposefully employed in various commercial products of each party. It followed that, as the Court of Appeals held (ix), "There was nothing unobvious, unexpected or surprising" in Gross' proposal to use such facings on an adhesive bandage.

The error into which the District Court had been led by plaintiff's argument that the use of smooth facings must have been unobvious because they were not earlier adopted was fully understood and exposed by the Court of Appeals. For, as that Court pointed out in its opinion, the adoption of smooth facings on adhesive bandages was delayed not by lack of knowledge of what the effect would be but by the absence of a supply of suitable materials. Among the requirements for a suitable facing material was the capability of being sterilized. The method of sterilization in general use at the time of this alleged invention (Gross was accorded a conception date in 1945 by the District Court) involved the use of steam at a high temperature. Most materials then available would not withstand the high temperature involved. Plaintiff's adoption of smooth facings on its commercial bandages was deferred from its "conception" in 1945, despite plaintiff's awareness of the principle involved, until May, 1953 and awaited the development by others (duPont and Eastman Kodak) of plastic materials in film form (Mylar and Kodapak IV) which would withstand the high temperatures involved in steam sterilization. Defendant's adoption of smooth fac-

ings on its adhesive bandages, also in 1953, initially involved the use of a vinyl-coated paper which, like Mylar and Kodapak IV, could withstand steam sterilization. Subsequently (early in 1954) defendant shifted to the same smooth facing material (polyethylene) which defendant had previously employed on its 281 industrial tape, a product not requiring sterilization. Defendant was enabled to use this material as facing on its sterilized adhesive bandages by the acquisition of equipment capable of sterilizing the product by exposure to gas (carboxide) at a lower temperature which polyethylene could stand.

The District Court had obviously been adversely influenced by its mistaken belief that defendant had learned about the advantage of smooth facings from plaintiff's patent or plaintiff's product. The Court of Appeals set this point right also, correctly pointing out that plaintiff did not introduce its smooth faced product *until after plaintiff had seen defendant's product*, which defendant had test-marketed in the Chicago area, where defendant's plant (Bauer & Black) is located. And, effectively disposing of any thought that defendant was taught by plaintiff's patent, plaintiff did not even file the first one of the succession of three applications on which the patent in suit was ultimately issued (in 1955) until after plaintiff had become aware of the test-marketing by defendant of its proposed new product with smooth facings.

The Reasons Asserted in the Petition for Granting a Writ are Not Presented by this Case

The petition lists as the "question presented":

> "Whether the Federal Courts are empowered, as a matter of law and despite the words 'obvious at the time the invention was made' in 35 U. S. C. § 103, to invalidate a patent for obviousness or lack of patentable invention on art which, although prior to the patentee's application filing date, is

subsequent to the date of his actual invention." (Petition, p. 2)

No such question is involved here.

The Court of Appeals stated in its opinion that "achievement of 'instantaneous adhesion' by the use of smooth facings was well-known in the art *and* had been put to practical use by each of the parties to this suit in *various* of their commercial products." (ix) Included among the "various products" in which defendant had put to practical use its knowledge that greater initial adhesiveness could be achieved by the use of smooth facing materials were two products which defendant had sold commercially prior to the earliest date ever claimed for Gross' alleged invention (1943). The earliest of these was a plastic backed tape sold as early as 1937 under the designation "Wet-Pruf". Contemporaneous (1939) records of the "tack value" (adhesiveness upon initial contact) of the smooth plastic backed tape showed values four or five times that of tape using the same adhesive but backed with ordinary cloth (IV 625, 626). (In tape which is sold in rolls the outer surface of the backing of each convolution of the tape serves as the facing for the adhesive surface of the next outer convolution. Smoothness imparted to the adhesive surface of one layer by its intimate contact with the smooth plastic backing of the next inner convolution is effective in producing "quick-stick" in precisely the same way as the smoothness produced by smooth facings on adhesive bandages.)

Another of the "various products" in which defendant's prior knowledge of this principle was put to practical use was a steam-sterilized surgical tape in which an interlining of Holland cloth was used between adjacent convolutions in preference to crinoline. This product was sold by defendant from 1938 to 1942. In a 1938 report, defend-

ant's employee Kemp characterized the Holland cloth of this tape (IV 617) as a material having "a highly calendered, smooth, glossy surface" and specifically stated that:

> *"The Holland cloth increases the apparent tack and adhesion due to the fact that a flat surface of pressure-sensitive mass results, rather than the pebbly surface which resulted from the crinoline."* (IV 618)

The District Court's Finding of Fact No. 63 (I 47) erroneously states

> ". . . there are no quantitative measurements in the Kemp report . . . for all that appears therein the increase in apparent tack which Kemp observed may have been slight and within the usual range of variation of adhesiveness . . ."

The Kemp report (IV 617) *does* include quantitative measurements. It includes a table (IV 620) which compares the tack of two tapes using identical mass formulations (68-68 mass), one faced with Holland cloth and the other with crinoline. It reports a tack of 60 after sterilizing the mass faced with Holland cloth, more than *six times* the value of 9.2 after sterilization reported for the same mass faced with crinoline.

The Court of Appeals did not refer specifically to either of these two clearly pre-Gross products, but they were included in the generality of its statement that the knowledge had been put to use in a variety of products.

The pre-Gross products just mentioned were referred to by defendant in its briefs and argument in the Court of Appeals, and its 281 tape, which used an interliner of polyethylene to achieve "quick-stick", was also referred to as a further example of the defendant's understanding and utilization of the principle involved which tended to con-

firm the conclusion to be drawn from the pre-Gross products and reports that there was nothing "unobvious, unexpected or surprising" in the Gross "teachings". It was entirely appropriate for defendant and the Court to have referred (v.) to this product as "an illustration" of the type of product which defendant had sold prior to Gross' alleged invention; it was particularly pertinent to refer to it because of the circumstance that the smooth facing which it employed was polyethylene, the very material which defendant later adopted for its adhesive bandages when it became possible to sterilize its bandages by a method which was non-destructive to the polyethylene.

Even though defendant's sale of 281 tape came after, rather than before, Gross' "conception" of his alleged invention in 1945, the fact that defendant purposefully used the smooth polyethylene for a facing long prior to the appearance of plaintiff's product on the market or the issuance of plaintiff's patent is another one of the historical facts which show how wrong the District Court had been in accepting plaintiff's contention that Gross had taught the world how "quick-stick" could be achieved.

Petitioner's complaint that the Court of Appeals erred by relying on the Cress bandages first sold in 1950 as proof of obviousness in 1945 is equally unfounded. There is nothing in the Court's opinion to support the contention that the Cress bandages played any such part in the Court's thinking. Actually, plaintiff had persuaded the District Court to enter findings which portrayed plaintiff as the first to introduce smooth faced adhesive bandages in the commercial market and that plaintiff's product had thereafter been copied widely by its competitors. This had been thought by the District Court to support its conclusion of patentability. In these circumstances, it was most pertinent for the Court of Appeals to point out that the District Court

had been wrong in this understanding and that in fact smooth faced adhesive bandages had been sold on the commercial market in this country by Cress before they were sold by either plaintiff or defendant.

In addition to serving the functions just pointed out, items such as the 281 tape and the Cress bandages show continued contemporaneous recognition and utilization of the knowledge that improved adhesiveness upon initial contact could be achieved by the use of smooth facings and emphasize lack of invention in the Gross patent under the doctrine of *Thomson Co. v. Ford Motor Co.*, 265 U. S. 445, 453 (1924), *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 185 (1925); *Graham v. Jeoffroy Mfg.*, 206 F. 2d 769, 771 (5 Cir. 1953), *Kay Patents Corp. v. Martin Supply Co.*, 202 F. 2d 47, 50-51 (4 Cir. 1953); and *Wilson Athletic G. Mfg. Co. v. Kennedy Sport. G. Mfg. Co.*, 233 F. 2d 280, 283 (3 Cir. 1956).

The ultimate question to be determined is whether the patented invention was obvious as of the date of the patentee's invention. But in considering this, the courts are not confined to evidence relating to the precise instant of time which a patentee may be able to establish as the instant in which he conceived the "invention"; events both before and after that time often throw light on what was and was not obvious at the time the invention was made. Independent, roughly contemporaneous though subsequent, conception by others has long been relied on as evidence of obviousness, as in the decisions cited above, and many others.

Contrary to petitioner's contentions, § 103 of the Patent Act of 1952 was not intended to, and did not, change the law so as to restrict the available evidence in considering obviousness.

The recent case, *Application of Palmquist et al*, 319 F. 2d 547 (CCPA 1963), relied on by petitioner, did not in-

tend or purport to overrule the long established principle that roughly contemporaneous art could be referred to in considering the question whether the patentee had made a patentable invention. It expressly acknowledges that "We think both logic and reason require us to interpret the provisions of 35 U. S. C. § 103 in accordance with the legal principles which preceded and are codified in it." (p. 551). Such legal principles included the legal principles established by *Thomson v. Ford* and the other cases cited above, as well as the Court of Customs and Patent Appeals own prior decision in *In re Wenzel*, 88 F. 2d 501 (CCPA 1937).

The *Palmquist* case was a special situation quite different from the facts of the present case and merely held that the Patent Office, in refusing to grant a patent, should not rely on a *secondary* reference with a date subsequent to the applicant's date of invention so as to make pertinent to applicant's invention other primary references which on their face did not have such pertinence. Nothing of that sort is involved here.

Petitioner asserts, as a further argument for review here, a conflict between the decision of the Court of Appeals here and an earlier District Court decision in the Southern District of New York—*Johnson & Johnson v. C. B. Stonwall, Inc.*, 193 F. Supp. 128.

The New York suit was brought by plaintiff against a small manufacturer, the trial lasted less than two days, and the appeal was dismissed following a settlement between the parties. Much of the most pertinent prior art relied on in the present case to invalidate the Gross patent was not before the judge in the New York suit. The Court of Appeals in the Second Circuit had no opportunity to pass on the decision in the New York case, and the decision by

the District Court in the New York case was thoroughly discussed and considered in the Seventh Circuit.

The prior District Court decision, rendered on inadequate evidence, furnishes no basis for a grant of a writ of certiorari here.

The petition should be denied.

Respectfully submitted,

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